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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/608,885	06/27/2003	Robert Keane	MPJ-D1	7851

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EXAMINER

GARCIA, GABRIEL I

ART UNIT PAPER NUMBER

2624

DATE MAILED: 09/09/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/608,885

Applicant(s)

KEANE ET AL.

Examiner

Gabriel I Garcia

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
  - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
  - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
  - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-15 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 6/21/03 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☒ Certified copies of the priority documents have been received in Application No. 09/557,571.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 06/27/2003.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_.

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### **DETAILED ACTION**

1. The abstract of the disclosure is objected to because it is not drawn to the invention being claimed. Correction is required. See MPEP § 608.01(b).

### ***Claim Rejections - 35 USC § 102***

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371© of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C. 122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

3. Claims 1-15 are rejected under 35 U.S.C. 102(b) as being anticipated by Laverty et al. (6,509,974).

With regard to claim 1, Laverty et al. teaches a computer implemented method for creating an electronic product design (see fig.4), the method comprising: providing one or more product design software tools (see abstract, the software being the modules) to a user computer (404), the

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tools being adapted to execute in the browser of the user computer (step 1212); providing a plurality of template images for viewing by the user of the user computer (e.g. fig. 8), in response to the user's selection of one of more template images, displaying a product design template associated with the selected template image (see abstract), allowing the user to provide content for incorporation by the tools into the selected product design template to create (cols. 10-12), displaying the electronic product design to the user (abstract, reads on the preview).

With regard to claims 2-3, Laverty et al. further teaches wherein the tools are downloaded to the user computer network and allowing the user to upload the electronic product design over the network to a server (see abstract and fig. 4). invisible indicia are printed with a luminescent ink or toner (see page 7).

With regard to claim 4, Laverty et al. further teaches allowing the user to place an order for production of a quantity of a physical product corresponding to the electronic product design (e.g. col. 10, lines 13-27).

With regard to claim 5, Laverty et al. further teaches wherein the tools display the electronic product design to the user in WYSIWYG form (e.g. col. 8, lines 16-31).

With regard to claims 6-7, Laverty et al. further teaches allowing the user to modify at least one feature of the selected product design template or user content during the electronic product design process (e.g. col. 8, lines 9-15).

With regard to claim 8, Laverty et al. further teaches wherein the template images are displayed at a reduced size that allows a plurality images to be simultaneously displayed to the user (e.g. col. 4, lines 4-17).

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With regard to claims 9-15, the limitations of claims 9-15 are covered by the limitations of claims 1-8 above.

***Conclusion***

4. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Hansen (6,509,974) teaches an automated job creation for job preparation.

Miyake (6,188,490) teaches a print processing device for image data editing.

Goertz et al. (6,173,295) teaches a method for creating a job ticket including information on components and print attributes of a print job.

Cheng et al. (6,012,070) teaches a digital design station procedure.

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gabriel I. Garcia whose telephone number is (703) 305-8751. The examiner can normally be reached Monday thru Thursday from 7:30AM-6:00PM.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 306-0377.

or faxed to:

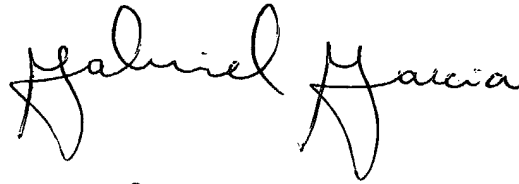
(703) 872-9306 (unofficial or official)

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**Gabriel I. Garcia**  
**Primary Examiner**  
**September 6, 2004**

A handwritten signature in black ink that reads "Gabriel Garcia". The signature is written in a cursive style with a large, stylized 'G' and 'G'.

**GABRIEL GARCIA**  
**PRIMARY EXAMINER**